

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

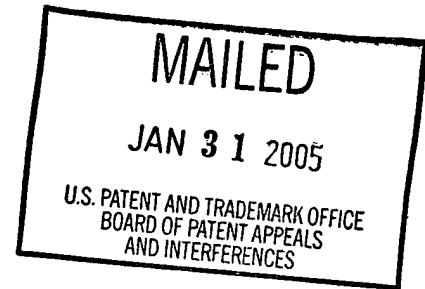
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BOMAN IRANI

Appeal No. 2004-2260
Application No. 09/333,383

ON BRIEF



Before LEVY, SAADAT, and MACDONALD Administrative Patent Judges.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 5-38. Claims 1-4 have been canceled.

Invention

Appellant's invention relates to a system and method to deliver personalized content to a small footprint device. This ability may be enabled by applications/services built on a lightweight containment framework for a small footprint device executing in conjunction with network-based computing services. A containment framework for small footprint device

applications/services is described herein. One embodiment of this containment framework is referred to as York 1.1. The containment framework enables module registration, lookup, instance tracking, etc. Modules in the containment framework may be used by other modules as services. The containment framework may be dynamic, allowing modules to be registered and loaded as desired or needed.

As described above, a containment framework for a small footprint device should be lightweight. The containment framework is able to function on a device with very little memory. For example, in one embodiment the containment framework may function on a device with only 300KB writeable memory and still leave enough memory space for several modules to operate. In addition, the containment framework may be responsive on devices with low processing power, such as small footprint devices with 16MHz-class chips. Appellant's specification at page 3, lines 4-18.

Claim 5 is representative of the claimed invention and is reproduced as follows:

A method for sending content to a small footprint device, the method comprising:

the small footprint device connecting to a first network;

the small footprint device communicating with a service accessible from the first network to send information to the service accessible from the first network;

the service accessible from the first network storing the information;

a service accessible from a second network receiving the information from the service accessible from the first network;

the service accessible from the second network generating content based on the information; and

the service accessible from the second network communicating with the small footprint device to send the content to the small footprint device.

References

The references relied on by the Examiner are as follows:

Rossmann	5,809,415	September 15, 1998
Razavi et al. (Ravazi)	6,253,122	June 26, 2001 (Filed June 14, 1999)

Rejections At Issue

Claims 5-18 and 21-38 stand rejected under 35 U.S.C. § 102 as being anticipated by Rossmann.

Claims 19-20 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Rossmann and Razavi.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 5-38 under 35 U.S.C. § 102 and 35 U.S.C. § 103.

¹ Appellant filed an appeal brief on February 17, 2004. The Examiner mailed an Examiner's Answer on April 6, 2004.

We also use our authority under 37 CFR § 41.50(b) to enter a new grounds of rejection of claims 5-38. The basis for this is set forth in detail below.

I. Whether the Rejection of Claims 5-18 and 21-38 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Rossmann does not fully meet the invention as recited in claims 5-18 and 21-38. Accordingly, we reverse. We discuss claim 5 as exemplary of claims 5-18 and 21-38.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 5, Appellant argues at pages 5-6 of the brief, that Rossmann does not teach a “network storing the information” and “generating content based on the [stored] information.” We agree. We have reviewed the Rossmann patent and do not find these features taught.

Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 19-20 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 19-20. Accordingly, we reverse.

With respect to dependent claims 19-20, we note that the Examiner has relied on the Razavi patent solely to teach “a Jini network” [answer, page 10]. The Razavi patent in combination with the Rossmann patent fails to cure the deficiencies of Rossmann noted above with respect to claim 5. Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

III. Rejection of Claims 5-38 Under 37 CFR § 41.50(b).

We make the following new grounds of rejection using our authority under 37 CFR § 41.50(b).

Claims 5-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “small footprint” in claims 5-38 is a relative term that renders the claims indefinite. The term “small footprint” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Appellant’s specification states at:

Page 1, lines 5-7, “The present invention relates to the field of small footprint, resource-constrained devices such as handheld computers, personal data assistants (PDAs), cellular phones, etc.”

Page 1, line 12, “The field of ‘smart’ small footprint devices is growing and changing rapidly.”

Page 1, lines 13-15, “Small footprint devices include handheld computers, personal data assistants (PDAs), cellular phones, global positioning system (GPS) receivers, game consoles, and many more such devices.”

Page 7, lines 5-8, “As used herein, a small footprint device is a hardware device comprising computing resources such as a processor, a system memory, and a display mechanism, but having significantly greater constraints on one or more of these resources than a typical desktop computer has.”

Page 7, lines 27-28, “Many small footprint devices are portable and/or are small compared to desktop computers, but are not necessarily so.”

The above quotes and the remainder of Appellant’s specification collectively give some examples of what is meant by “small footprint”. However, the specification does not provide any clear boundary as to which devices are “small footprint” and which devices are not. For example, the meaning of the term “typical desktop computer” is continuously changing and is open to debate even at a given moment in time. Therefore, the claims fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Conclusion

In view of the foregoing discussion, we have not sustained the rejections under 35 U.S.C. § 102 of claims 5-18 and 21-38; we have not sustained the rejections under

35 U.S.C. § 103 of claims 19-20. We have entered a new grounds of rejection against claims 5-38 under 37 CFR § 41.50(b).

As indicated *supra*, this decision contains a new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, by final rule notice, 69 Fed. Reg 49960, 50008 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21, 61 (September 7, 2004)).

37 CFR § 41.50(b) provides that, “[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review.”




37 CFR § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...
- (2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record ...

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

REVERSED

37 CFR § 41.50(b)

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Stuart S. Levy)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Mahshid Saadat)	
Administrative Patent Judge)	APPEALS AND
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Allen R. MacDonald)	
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